

Appl. No. : 10/004,543
Filed : December 4, 2001

REMARKS

Claims 11-19 were pending in the present application. By way of the present amendment, Claims 20-29 have been added; accordingly, Claims 11-29 are now pending for consideration. In response to the Office Action mailed March 2, 2004, Applicants respectfully request that the Examiner consider the following comments.

Rejection of Claims 11-19 under 35 U.S.C. § 103(a)

The Office Action of March 2, 2004 rejected Claims 11-19 under 35 U.S.C. § 103(a) as being unpatentable over U.S. patent no. 6,349,001 to Spitzer ("Spitzer") in view of U.S. patent no. 6,311,155 to Vaudrey et al. ("Vaudrey"). Applicants respectfully traverse this rejection because Spitzer, alone or in combination with Vaudrey, fails to disclose, teach or suggest the elements of the claims. See M.P.E.P. § 2143 (stating that in order to establish a *prima facie* case of obviousness for a claim, the prior art references must teach or suggest all the claim limitations).

Spitzer discloses an industrial safety assembly which includes a telecommunications receiver carried inside of an eyeglass, telecommunications transmitter carried inside of the eyeglass, a battery carried by the eyeglass, and a pair of earphones and a microphone is connected to an orbital of the eyeglass. As noted by the Examiner, Spitzer fails to teach an MP3 storage device.

Applicants wish to point out that Spitzer fails to teach a system in which audio storage and retrieval circuitry is supported by the frame of the eyeglass. In fact, Spitzer does not disclose any memory device for audio or video storage and playback carried by any portion of the eyeglass frame.

Spitzer explains that the Eyeglass Interface System may be connected to additional components located within an external plug-in module 1001 located on a strap 1002 behind a user's head or placed in a pocket or worn on a belt. *Id.* at col. 9, ll. 55-57, col. 9, l. 65-col. 10, l. 4, and Figure 20. The only storage devices disclosed by Spitzer as possibly providing playback capability are tape recorders, recordable digital video disk systems, and recordable compact disk systems, (see Spitzer, col. 10, ll. 65-67) all of which are clearly too large to be placed in the eyeglass frame. Rather, one of ordinary skill in the art, in light of the Spitzer disclosure, would

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understand that Spitzer suggests that such playback capable devices would be placed in the module 1001 hanging from the strap 1002.

Vaudrey is directed to a method for providing multiple users with voice-to-remaining audio (VRA) adjustment capability. Vaudrey discloses that an audio system for performing the method can be incorporated into a variety of personal listening devices (PLDs). Such PLDs include MP3 playback devices and eyewear or headwear incorporating speakers, in addition to several other devices. It was the Examiner's position that it would have been obvious to incorporate the MP3 player of Vaudrey into the eyeglass of Spitzer.

Applicants wish to point out that Vaudrey does not disclose, teach or suggest placing a memory and playback device, including an MP3 format memory device, inside of an eyeglass frame. Vaudrey similarly fails to teach or suggest supporting a memory and playback device, such as an MP3 format memory device and retrieval circuitry, from an eyeglass frame.

Rather, Vaudrey merely suggests that the voice-to-remaining audio (VRA) technology can be incorporated into a known MP3 player device. Applicants submit that one of ordinary skill in the art would understand this statement as suggesting that a known MP3 player could be modified to include the VRA technology. Additionally, one of ordinary skill in the art would understand that eyeglasses with speakers would be connected to such a known MP3 player device with, for example, an audio cable. However, no obvious combination of Spitzer and Vaudrey results in an eyeglass having an MP3 format memory and retrieval circuit carried by the eyeglass frame. .

The structure of the device of independent Claim 11 includes an MP3 format memory device carried inside of an eyeglass frame. As discussed above, the Spitzer reference fails to disclose any audio storage and playback device, including an MP3 player, carried inside of an eyeglass frame. Therefore, even if one were to combine the teachings of Spitzer with Vaudrey, the combination would still fail to teach an MP3 format memory device carried inside of an eyeglass frame.

Because the references cited by the Examiner do not disclose, teach or suggest an MP3 format memory device carried inside of an eyeglass frame, the Applicants assert that Claim 11 is not obvious in view of the Spitzer and Vaudrey references. The Applicants therefore respectfully submit that Claim 11 is patentably distinguished over the cited references and the Applicants respectfully request allowance of Claim 11.

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Dependent Claims 12-16 which depend from Claim 11 are also patentable, not only because they depend from Claim 11, but also on their own merit. Accordingly, Applicants respectfully request allowance of Claims 12-16.

The structure of the device of independent Claim 17 includes a means for storing music in an MP3 format inside of an eyeglass frame. For the same reasons articulated above with respect to Claim 11, Claim 17 is not obvious in view of the Spitzer and Vaudrey references. The Applicants therefore respectfully submit that Claim 17 is patentably distinguished over the cited references and the Applicants respectfully request allowance of Claim 17.

Dependent Claims 18-19 are also patentable, not only because they depend from Claim 17, but also on their own merit. Accordingly, Applicants respectfully request allowance of Claims 18-19.

New Claims 20-29

New Claims 20-29 are fully supported by the specification as originally filed, thus, no new matter has been added. Additionally, Applicants submit that Claims 20-29 also clearly and non-obviously define over the cited references.

Please charge any additional fees, including any fees for additional extension of time, or credit overpayment to Deposit Account No. 11-1410.

CONCLUSION

For the foregoing reasons, it is respectfully submitted that the rejections set forth in the outstanding Office Action are inapplicable to the present claims. Accordingly, early issuance of a Notice of Allowance is most earnestly solicited.

The undersigned has made a good faith effort to respond to all of the rejections in the case and to place the claims in condition for immediate allowance. Nevertheless, if any undeveloped

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issues remain or if any issues require clarification, the Examiner is respectfully requested to call Applicants' attorney in order to resolve such issue promptly.

Respectfully submitted,

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Dated: _____

9/1/04

By: _____

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